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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/623,899 | 07/21/2003 | Matthew J. Newsome | 014801000510 | 7640 |
| 20350 | 7590 | 09/21/2005 | | |
| TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | EXAMINER LE, UYEN CHAU N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

Office Action Summary

Application No.

10/623,899

Applicant(s)

NEWSOME ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☒ Claim(s) 9 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 11 July 2005.

In view of the Applicant's argument with respect to claims 1-20, pages 10-11, this action is therefore made NON-FINAL. New ground(s) of rejection set forth below.

Obviousness-Type Double Patenting

2. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,595,416) (hereinafter '416).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claim 17 of the instant application, Applicants claim **a method of adding a plurality of transaction values to fare cards**, the method comprising the steps of: **"providing a terminal in communication with a transit station controller for adding value to the plurality of fare cards utilizing credit and debit accounts only"**; **"displaying instructions on the terminal for prompting a patron"**; **"reading a fare card of the plurality of fare cards**

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utilizing one of a magnetic stripe card reader and a **contactless card reader**"; "communicating with the transit station controller for authorizing a transaction value of the plurality of transaction values"; and "writing the authorized transaction value to the fare card utilizing the one of a magnetic stripe card reader and **contactless card reader**". The '416 patent discloses a **method of adding value to fare cards**, the method comprising the steps of: "providing a terminal in communication with a transit station controller for adding value to fare cards utilizing **credit and debit accounts only**"; "displaying **instructions** on the terminal for prompting a patron"; "reading a smart card utilizing one of a contact smart card reader and a **contactless smart card reader**"; "communicating with the transit station controller for authorizing a debit/credit card transaction"; and "writing a new value to the smart card". Although the scope of claim 17 of the present application and claim 12 of '416 patent are almost identical, the difference between the present claimed invention and the '416 patent is that the present claimed invention is a broader recitation of the '416 patent (e.g., the present claimed invention recites "a **fare card**, etc." whereby the '416 patent recites specifically a fare card is "a **smart card**, etc."). Thus, with respect to above discussions, it would have been obvious to an artisan of

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ordinary skill in the art at the time the invention was made to use the teaching of claim 12 of '416 patent as a general teaching for having a method for **adding value to fare cards** with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broadened and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi (JP 09-305,806) in view of Hiroya et al (US 5,754,654).

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Re claims 1-6 and 12-15: Kiribuchi discloses a terminal for conducting a plurality of cashless transactions for adding value to a plurality of fare cards, the terminal comprising: a patron display 1 for displaying information and instructions to a patron for adding value to a fare card of the plurality of fare cards; at least one fare card reader [21, 28] for reading from and writing to the fare card (English translation: figs. 2-3; paragraphs [0023-0024]); a payment interface means comprising a debit/credit card reader [2, 22] for accepting at least one of a credit card and a debit card (English translation: figs. 2-3; paragraphs [0025-0027]); and a control and memory assembly 20 comprising: means for controlling the patron display 1; means 31 for communicating with the at least one fare card reader for reading from and writing to the at least one fare card to complete at least one cashless transaction of the plurality of cashless transactions; means 32 for communicating with the payment interface means to obtain debit/credit information (English translation: figs. 2-3; paragraphs [0028-0033]); means [28, 12] for issuing a new or recycled fare card (Kiribuchi: English translation; figs. 2-3; paragraph [0032]).

Kiribuchi is silent with respect to means for storing a history of the at least one cashless transaction; wherein the

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fare card comprises contact/contactless smart card and the system comprises contact/contactless smart card reader, respectively.

Hiroya et al teaches an electronic ticket system comprises a fare/ticket card 30 is a contact/contactless smart/IC card and terminal 3 having a contact/contactless smart/IC card reader/writer 26; the system further comprises a storage for storing transaction history (figs. 1-4; col. 11, line 35 through col. 12, line 52).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hiroya et al into the system as taught by Kiribuchi in order to provide Kiribuchi with the ability of storing all transactions associated with the system for later use. Furthermore, such modification would provide Kiribuchi with a universal system, which can utilize different types of fare cards (i.e., magnetic or non-contact smart card, etc.); thus providing the user with the flexibility in choosing a desired fare card (i.e., magnetic or non-contact smart card, etc.) when using public transportation system.

Re claim 10: a plurality of selection buttons 36 adjacent the patron display for selecting options in response to the displayed information and instructions (baker et al: fig. 1).

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6. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi in view of Raspotnik (US 5,832,090). The teachings of Kiribuchi have been discussed above.

Re claims 17-19: Kiribuchi has been discussed above but is silent with respect to communicating with the transit station controller for authorizing a transaction value of the plurality of transaction values; and writing the authorized value to the fare card utilizing the one of a magnetic stripe card reader and the contactless card reader.

Raspotnik teaches a fare collection system comprises a reader/writer 14 communicating with the central host computer 15, which controls the mass transit system, for authorizing a transaction value (i.e., increase the data value stored in the fare card/transponder 11) (col. 4, lines 12-43 and col. 5, lines 6-35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Raspotnik into the system as taught by Kiribuchi in order to provide Kiribuchi with a time consumption system wherein the transaction authorization process is determined directly by the transit system controller, which eliminates a long waiting time of authorizing process from credit companies.

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7. Claims 7, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiribuchi as modified by Hiroya et al as applied to claim 1 above, and further in view of Adams (US 5,255,182). The teachings of Kiribuchi as modified by Hiroya et al have been discussed above.

Re claims 7, 8 and 16: Kiribuchi/Hiroya et al has been discussed above but is silent with respect to the history of the at least one cashless transaction is uploaded from the control and memory assembly to the transit station area controller at a pre-determined time, wherein the pre-determined time for uploading the history is after each cashless transaction of the plurality of cashless transactions.

Adams teaches terminal 1 can be programmed to upload transaction data spontaneously after a preset time interval or after a preset number of transactions (i.e., a preset number of transactions can be 1 or after each transaction) (col. 11, lines 6-21).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate teachings of Adams into the system as taught by Kiribuchi/Hiroya et al in order to provide Kiribuchi/Hiroya et al with more feasible system in which information data of each transaction can be upload and stored at the server, thus a large capacity

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memory is not required at each terminal for storing transaction data. Furthermore, such modification would provide the user flexibility in retrieving transaction data from the server/host at any station/terminal via the network system, and therefore an obvious expedient.

Allowable Subject Matter

8. Claims 9 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure and method for conducting a plurality of transaction values to a plurality of fare cards comprising, among other things, the fare card is a special status fare card, wherein the transit controller has pre-authorization to utilize stored debit/credit information for authorizing the transaction value; the controller adds value to the special status fare card without obtaining the credit/debit information through the

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debit/credit card reader as set forth in the claimed combination.

Raspotnik teaches the mass transit central host computer 15 communicating with a reader/writer 14 for authorizing a transaction value (i.e., increase the data value stored in the fare card/transponder 11) (col. 4, lines 12-43 and col. 5, lines 6-35), but is silent with respect to a special status fare card, wherein the transit controller has pre-authorization to utilize stored debit/credit information for authorizing the transaction value.

Response to Arguments

10. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited references to Hiroya et al and Raspotnik have used in the new grounds of rejection to further meet the claimed limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau

N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon-Fri. 5:30AM-2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G. LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
Examiner
AU 2876

September 17, 2005